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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/077,397	02/15/2002	Peter J. Wonfor	0085C	4138
31665	7590	07/18/2007	EXAMINER	
PATENT DEPARTMENT MACROVISION CORPORATION 2830 DE LA CRUZ BLVD. SANTA CLARA, CA 95050			VU, NGOC K	
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/077,397	WONFOR ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Ngoc K. Vu	2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 13 April 2007.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 63-124 is/are pending in the application.
  - 4a) Of the above claim(s) 93-96, 98 and 118-124 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 63-92, 97 and 99-117 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)	5) <input type="checkbox"/> Notice of Informal Patent Application
Paper No(s)/Mail Date: _____	6) <input type="checkbox"/> Other: _____

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***Response to Arguments***

1. Applicant's arguments filed 4/13/2007 have been considered but are moot in view of the new ground(s) of rejection.
2. Newly submitted claims 93-96, 98, 118, 119 and 120-124 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 93-96, 104-109 and 118-124 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Drawings***

3. Figure 4 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Specification***

4. The disclosure is objected to because of the following informalities: the description of disclosure does not indicate that FIG 4 is a diagram illustrating components in a prior art system. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 88, 89, 92 and 104-117 are rejected under 35 U.S.C. 102(b) as being anticipated by Ryan (US 5,590,194 A).

Regarding claims 88, 89, 92, and 104-107, Ryan teaches an apparatus for receiving and process video signal comprising: a device (224 – figure 8) for reception of video signal derived via an optical signal; a digital signal decompression circuit (decompressor 249 – figure 8); a memory circuit (within circuitry 240) having copy protection control software enables or disables recording/viewing the video signal; an NTSC encoder (250 – figure 8) for providing a video signal out; copy protection control circuit (figure 8) including copy protection information bits; and wherein video signal is provided with a copy protection signal activated or deactivated (by anticopy control signal) (see figure 8; col. 6, line 42 to col. 7, line 27).

Regarding claims 108-109, Ryan teaches modifying video signal by adding a plurality of pulses pairs to the otherwise used lines of the video signal VBI, each pulse pair being a negative going pulse followed closely by a positive-going pulse (see col. 7, lines 33-38).

Regarding claim 110, Ryan teaches an apparatus for providing at least one video copy protection signal from a plurality of programmable video copy protection signals, wherein the video copy protection signals may include copy protection for analog and or digital video signals, comprising: a configuration circuit (copy protection circuitry – figure 8) for providing copy protection configuration bits indicative of the programmable video copy protection signals, including vertical blanking interval pulses; and a mode circuit (220 – figure 8) for providing mode

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control bits for enabling one or more of the programmable video copy protection signals (see abstract; col. 7, lines 21-38; figure 8).

Regarding claims 111-117, Ryan's apparatus further comprises encoder 250 which outputs the video signals 238 to a display, a digital decompression circuit 249, microprocessor 234 & 236 (see figure 8; col. 7, lines 57-60).

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 63-80, 82-85, 97, 99-101 and 103 are rejected under 35 U.S.C. 102(e) as being anticipated by Kim et al. (US 5,799,081 A).

Regarding claim 63, Kim teaches a method of providing programmable copy protection of signal material transmitted via digital delivery networks, wherein one or more copy protection signal prevents copying and/or subsequent viewing of a recording of the recorded signal material (providing an illegal view/copy protection method and apparatus for a digital broadcast system) comprising: generating a copy protection command having a mode control command and programmable configuration bit patterns indicative of respective one or more copy protection signals (CPTC information to generate a control word and a signal for controlling the protection of copyright – col. 9, lines 42-44; col. 10, lines 57-59); transmitting the signal material and the mode control command to at least one a plurality of remote device (receiver) coupled to the networks (e.g., cable, satellite or terrestrial broadcast network) (figures 9 and 16; col. 14, lines 36-41; col. 15, lines 8-12); and providing in the one or more copy protection signal to for

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the signal material in the at least one device in response to one or more corresponding configuration bit pattern selected by the mode control command, to prevent said copying and/or subsequent viewing of the recording of the recorded signal material (col. 10, line 51 to col. 11, line 22; figures 9, 10).

Regarding claim 64, Kim teaches transmitting the copy protection signal to the device (receiver); and applying the transmitted copy protection signal to the signal material in response to the one or more configuration bit pattern selected by the mode control command (e.g., descrambling the signal material according to the control word output) (see col. 15, lines 13-32).

Regarding claims 65-69, Kim further teaches storing the copy protection signal in the device (after steps 110-111); recovering the one or more copy protection signals in response to a corresponding one or more configuration bit pattern (control word) selected by the mode control command (CA information and/or CPTC information); and applying the one or more copy protection signal (scrambling or descrambling the signal material) corresponding to the bit patterns selected by the mode command (see col. 9, lines 38-50).

Regarding claims 70-75, Kim teaches system and method of controlling programmable copy protection of proprietary signal material transmitted via digital delivery networks, wherein a service provider enables one or more copy protection signal which prevents unauthorized copying and/or subsequent viewing of a recording of the signal material by consumers even when the original signal material is watchable, the system comprising: a copy protection command having a mode control command and programmable configuration bit patterns indicative of respective one or more copy protection signals (e.g., CPTC information to generate a control word and a signal for controlling the protection of copyright – col. 9, lines 42-44; col. 10, lines 57-59); transmitting the copy protection signal to the device (receiver); a device located

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with each consumer for applying the copy protection signal to the signal material in response to the one or more configuration bit pattern selected by the mode control command (e.g., descrambling the signal material according to the control word output) (see col. 15, lines 13-32).

Further regarding claims 72-73 and 76-77, Kim further teaches storing the copy protection signal in the device (after steps 110-111); recovering the one or more copy protection signals in response to a corresponding one or more configuration bit pattern (control word) selected by the mode control command (CA information and/or CPTC information); and applying the one or more copy protection signal (scrambling or descrambling the signal material) corresponding to the bit patterns selected by the mode command (see col. 9, lines 38-50).

Regarding claim 78-79, Kim further teaches a plurality of copy protection signals are identified by a corresponding configuration bit pattern which is selectable by the mode control command

Regarding claims 80 and 82-85, Kim teaches a system and method of providing programmable copy protection of a video signal, wherein a plurality of copy protection signals are available for application to the video signal, comprising: transmitter (as shown in figures 9, 16) providing control bits (control word) (as shown in figures 10, 16) over a network (e.g., cable, satellite or terrestrial broadcast network) wherein the receiver comprising a circuit providing a programmable copy protection signal and or programmable copy protection information in reception or response to the one or more control bits (e.g., to allow recording the program according to the copy protection control signal) (col. 14, line 4 to col. 15, line 40; col. 10, line 51 to col. 11, line 22; figures 9-10 and 16).

Regarding claims 97 and 103, Kim teaches an apparatus (figure 16) comprising a receiver (202) of digital signals that includes the capability of programming at least part of a

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video copy protection signal, comprising: circuitry (211) for providing one or more mode bits and one or more configuration bits indicative of one or more copy protection signal; and wherein the one or more mode bits enables programming of the one or more copy protection signals onto the received digital signals (control word for prohibiting illegal view/copy) (see figure 16; col. 14, lines 45-49; col. 15, lines 20-26 and abstract).

Regarding claims 99-101, Kim's receiver includes a decoder 213 and the service provider includes satellite broadcast (see col. 15, lines 8-10; figure 16).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 86 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kim et al. (US 5,799,081 A).

Kim teaches the system receives program over network such as satellite and cable (see col. 15, lines 8-10). Kim does not explicitly teach the program including electronic programming guide. Official Notice is taken that providing electronic program guide over the broadcast network is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Kim by providing electronic program guide in order to allow the viewer easily to select the scheduled program for viewing.

11. Claim 90 and 91 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ryan (US 5,590,194 A).

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Ryan discloses that the system provides the signals over transmission channels from a source (see abstract; col. 2, lines 17-21). Official Notice is taken that providing video signal from a video service provider via satellite or cable network is well known in the art. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the playback system of Ryan by providing video signal from a video service provider via satellite or cable network in order to remotely distribute video program to a number of viewers over the network.

12. Claims 79, 81, 87 and 102 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kim et al. (US 5,799,081 A) in view of Oguro (US 5,907,655 A).

Regarding claims 79, 81, 87 and 102, Kim does not explicitly teach copy protection using AGC or color stripping technique. However, Oguro discloses a system and method for digital video signals in which the copy protection function using techniques, such as AGC or color stripping, can be effective in a digital VTR (see abstract; col. 1, lines 41-50). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Kim by using techniques, such as AGC or color stripping, as taught by Oguro in order to effectively provide function of copy protection in a digital VTR.

### ***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ngoc K. Vu whose telephone number is 571-272-7306. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ngoc Vu/  
NGOC K. VU  
PRIMARY EXAMINER  
Art Unit 2623

July 10, 2007